

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner rejects claims 1-16 and 20-25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,081,349 to Iwasaki (hereinafter "Iwasaki") in view of U.S. Patent No. 6,663,560 to MacAulay et al., (hereinafter "MacAulay") and further in view of U.S. Patent No. 6,844,920 to Luellau (hereinafter "Luellau"). Furthermore, the Examiner rejects claims 17-19 under 35 U.S.C. § 103(a) as being unpatentable over Iwasaki, MacAulay and Luellau and further in view of U.S. Patent Application Publication No. 2002/0024015 to Hoffman et al., (hereinafter "Hoffman").

In response, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. § 103(a) for at least the reasons set forth below. However, independent claim 1 has been amended to clarify its distinguishing features. Specifically, independent claim 1 now recites:

"wherein the light detecting element detects the light transferred from the sample body by the at least one lens."

The amendment to claim 1 is fully supported in the original disclosure. Thus, no new matter has been entered into the original disclosure by way of the present amendment to claim 1.

In the previous Response, Applicants argued that the acousto-optic modulators (13A and 13B) disclosed by Iwasaki modulate a light intensity of laser beams 11A and 11B, respectively, and do not modulate the beam pattern by imparting shade to the converged linear light as is recited in independent claim 1.

The Examiner now admits as such and has additionally cited Luellau arguing that Luellau is a related scanning device and that the same discloses that "all of the pixels of

(light modulator 7) are triggered with an average gray value by generating a gray mask in order to invert the gray shades of pixels which is a function of pixels luminosity distribution produced on the printing plate” and an “artwork pattern can be provided with an electronically stored gray mask that corresponds to the printing plate or object.” The Examiner concludes that it “would have been obvious for one of ordinary skill in the art to modify Iwasaki in view of MacAulay et al and further in view of Luella[u] to include a light modulator that can project a gray shade onto the converged linear light in order to improve the pattern of the object resulting in a clear and precise image that can be displayed on a monitor for further analysis.”

Applicants respectfully disagree.

After the previous argument by Applicants that the cited references do not teach the above feature recited in the claims, the Examiner has responded with an additional reference, allegedly teaching such missing feature. Thus, Applicants respectfully submit that the Examiner is using the claims as a “blueprint” for piecing together elements in the prior art to reject the claims, which constitutes hindsight and is improper.¹

Firstly, Applicants respectfully submit that Luellau is not “a related scanning device” as argued by the Examiner. Luellau is directed to a projector, while the scanning optical microscope of claim 1 is directed to a fluorescence observation system (microscope).

Secondly, Luellau does not include an observation system. The scanning optical microscope of claim 1 includes both an illumination and observation system. The

¹ In re Rouffet, 47 USPQ2d 1457-58 (Fed. Cir., July 15, 1998) (“Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.”)(emphasis added).

system of Luellau is a scanning system only and cannot take an image of the specimen. In contrast, the claimed invention illuminates the specimen and also observes the specimen using an observation system.

For at least these reasons, those of ordinary skill in the art would not look to the teachings of Luellau to combine the same with that of Iwasaki and MacAulay. Furthermore, the scanning optical microscope of claim 1 is not a predictable variation of that which is taught in either Iwasaki or MacAulay.

Still further, Luellau does not include a detection system. Luellau is only directed to illuminating a specimen, whereas the claimed invention is directed to a scanning optical microscope including a light detection system. Claim 1 has been amended as discussed above to clarify this feature.

With regard to the rejection of claims 1-16 and 20-25 under 35 U.S.C. § 103(a), independent claim 1 is not rendered obvious by the cited references for at least the reasons set forth above. Accordingly, claim 1 patentably distinguishes over the prior art and is allowable. Claims 2-16 and 20-25, being dependent upon claim 1, are thus at least allowable therewith.

With regard to the rejection of claims 17-19 under 35 U.S.C. § 103(a), since independent claim 1 patentably distinguishes over the prior art and is allowable, claims 17-19 are at least allowable therewith because they depend from an allowable base claim. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 17-19 under 35 U.S.C. § 103(a).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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